

HONEYWELL'S CLOSING STATEMENT PART 2 OF 2

Sundstrand's Use of Hindsight Improper and Unavailing

- In the obviousness context
 - “Most inventions arise from a combination of old elements and each element may often be found in the prior art.”

In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006)
(citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)).

- It is well-settled that the accused infringer
“cannot pick and choose among the individual
elements of assorted prior art references to
recreate the claimed invention.”

SmithKline Diagnostics, Inc., v. Helena Labs. Corp.,
859 F.2d 878, 887 (Fed. Cir. 1988).

Sundstrand's Use of Hindsight Improper and Unavailing

- No surge control system existed in 1982-83 that had the combination of features (however they are defined) found in the APS 3200.

(HON ¶168.)

- No evidence of combination other than via hindsight.

Disputed Issue

- Whether Sundstrand may combine references without proving motivation
 - No. Sundstrand must, but did not, demonstrate motivation. (HON ¶¶194-196.)
 - Honeywell proved no motivation existed. (HON ¶198.)
 - Indeed, because L1011 APU surge control system was “state-of-the-art” in 1982-83, no motivation existed. (HON ¶177.)

Disputed Issue

- Sundstrand argues that the APS 3200 surge control system was developed between late 1989 and late 1993. (HSC ¶77.)
 - This is not correct.
 - As late as 1994, considered moving static pressure sensors to eliminate the double solution. (HON ¶50.)
 - The infringing equivalent was not developed until 1995. (HON ¶¶41-51.)

APS 3200's Long Development History Confirms It Was Unforeseeable

- An accused infringer's failures in the design of a product that employed the patented technology is evidence suggesting nonobviousness.

Intel Corp. v. U.S. Int'l Trade Comm'n,
946 F.2d 821, 835 (Fed. Cir. 1991)

- “If people are clamoring for a solution, and the best minds do not find it for years, that is practical evidence--the kind that can't be bought from a hired expert, the kind that does not depend on fallible memories or doubtful inferences--of the state of knowledge.”

In the Matter of Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation,
831 F.Supp. 1354, 1378 (N.D.Ill. 1993) (Easterbrook, J.), *aff'd* 71 F.3d 1573 (Fed. Cir.1995)

Sundstrand Testimony Establishes That Equivalent Was Not “Readily Known” in 1982-83

- “The patentee, as the author of the claim language, may be expected to draft claims encompassing *readily known equivalents*.”

Festo, 535 U.S. at 740 (emphasis added)

- “[U]sually if the alleged equivalent represents . . . technology that was not known in the relevant art, then it would not have been foreseeable.”

Festo, 344 F.3d at 1369

Tangential Relation

- The “tangential relation” prong of the *Festo* rebuttal test focuses on whether “the rationale underlying the amendment [] bear[s] no more than a tangential relation to the equivalent in question.”

Festo, 535 U.S. at 740.

- The test “asks whether the reason for the narrowing amendment was peripheral, or not directly relevant, to the alleged equivalent.”

Festo, 344 F.3d at 1369.

Tangential Relation Inquiry Is Based Solely on the Patent File

The inquiry “focuses on the patentee’s *objectively apparent reason* for the narrowing amendment,” a reason which, “should be discernible from the prosecution history record.”

Festo, 344 F.3d at 1369 (emphasis added).

No Dispute: Tangential Relation

- Neither the APS 3200 surge control system nor IGV position were mentioned by Examiner or Honeywell during prosecution.
(HON ¶218.)
- The Examiner never rejected the disputed claims on prior art grounds.
(HON ¶¶22, 24, 36.)
- The Examiner allowed claims that lacked IGV position.
(HON ¶23.)

No Dispute: Tangential Relation

- Honeywell rewrote dependent claims to which Examiner *objected* in independent form, as Examiner requested.

(HON ¶¶22-24, HSC ¶¶59-61.)

- This is the “objectively apparent” reason for the amendments.

No Dispute: Honeywell Added More Than Just IGV to Claim 8

- “substantially independent of the temperature of the compressed air”
- “adjustable control set point representing the said desired value of said parameter”
- Neither limitation is part of 8(f), what Sundstrand calls the “IGV Limitation”

(HSC¶ 287)

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achieved said minimum flow rate through said
perforated tubular member is sufficient
 to prevent the formation of any erosion
area of the conduit in any shape
 of the irregularly-shaped aperture --

Honeywell Amendment Adds Multiple Limitations to Claim 8

generating an output signal indicative of said value, [the] said value of said flow-related parameter [is] being substantially independent of the temperature of the compressed air[.];

(e) comparator means for receiving said sensing means

desired value thereof, said comparator means [have] having an adjustable control set point representing said desired value of said parameter [; and said accessory power unit further comprises]

[a] means for transmitting to said comparator means a sense signal for varying said set point as a function of the

position of said inlet guide vane[in accordance with a predetermined

and case schedule]; and

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[(1)] (a) control means for receiving said error

Honeywell Amendment Also Adds Multiple Limitations to Claim 19

- Application Claim 35 (Claim 19 of ‘893)
 1. “a guide vane position sensor”
 2. “a function generator”
 3. “coupled in series”
 4. “between the inlet guide vanes and said input portion of said comparator.”

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 (Amended) The control system of claim 3 wherein the compressor has a control system for receiving a substantially constant engine flow rate through a flow restriction and for adjusting engine flow rate through a flow restriction in response to a change in engine flow rate from a compressor on the like having adjustable intake valve, the first having a supply outlet connected to a conventional compressor having a variable supply air demand, the flow restriction being an exhaust valve, said control system comprising:
 (a) a flow regulating valve adapted to be regulated in the exhaust outlet and operable to exhaustively vent air flow in accordance therewith;
 (b) a sensitive device having a sensing portion adapted to be positioned in the flow to sense through a transducer a pressure relative to the air flow through the flow said sensitive device having means for outputting;
 (c) an adjustable inlet control valve having an input portion coupled to said output portion of said sensitive device, and an outlet adapted to intercept an error signal;
 (d) a proportional controller having an input coupled to said output of said controller and further having an output;
 (e) an integral controller having an input coupled to said output of said controller and further having an output;
 (f) a summing junction having an input coupled to the output of said controller and further having an output;
 (g) a power having a first input coupled to said output of said proportional controller, a second input coupled to said output of said integral controller, and an output coupled to said flow restriction device, and said control system further comprising:
 (1) a guide valve portion having an input and a sensitive generator coupled in series between the last guide valve and said input portion of said compressor;
 (2)

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Honeywell Amendment Also Adds Multiple Limitations to Claim 19

44 (Amended) The control system of claim 19 wherein the comparison has a control system for receiving a substantially constant value and a control system for receiving a substantially constant value of the inlet guide vane position.

OF SAID PROPORTIONAL CONTROLLER, A SECOND INLET COUPLED TO SAID

OUTLET OF SAID INTEGRAL CONTROLLER, AND AN OUTLET COUPLED TO SAID

FLOW REGULATING DEVICES; AND SAID CONTROL SYSTEM FURTHER COMPRISES:

(1) A GUIDE VANE POSITION SENSOR AND A FUNCTION GENERATOR COUPLED IN SERIES BETWEEN THE INLET GUIDE VANES AND SAID INPUT PORTION OF SAID COMPARATOR;

HSB 401472

Honeywell Amendment Also Adds Multiple Limitations to Claim 4

- Application Claim 51 (Claim 4 of ‘194)
 1. “adjustable inlet guide vanes”
 2. a control system that “adjust[s] the relationship between the magnitudes of said integral and proportional control signals and the magnitudes of said parameter variations as a function of the position of the inlet guide vanes.”

Honeywell Amendment Also Adds Multiple Limitations to Claim 4

A -- Economy (The method of claim 4 wherein utilizing a compressor of a gas turbine engine to power pneumatically-operated actuators having a variable inlet air flow demand, the compressor being driven by a gas turbine engine, the method comprising:

(a) driving compressible inlet guide vanes; and

(b) controlling the speed of

(a) interconnecting a supply duct between the compressor and the pressure-operated poppet valve;

(b) flowing discharge air from the compressor through

(c) maintaining an essential contract minimum supply

supply that in response to variations therein of the value of a cost parameter, flow-related parameter, the flow rate of air advanced from said supply duct region varied in a proportional and time-integral manner.

acid maintaining some binding to the edge of proline
integral control signal in response to acid
flow-related parameter, generating a positional control
signal to operate said pump; generating a flow-related
parameter, generating a positional control signal in
response to acid variations in said flow-related parameter, and
operating said pump in response to said positional control
signal to operate said pump blood valve; and

[illegible]

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Honeywell Amendment Also Adds Multiple Limitations to Claim 4

4 - dependent (the) A method of (claim 4) wherein adjusting a compressor of a gas turbine engine to power electronically-operated

A compressor of a gas turbine engine to power electronically-operated

apparatus having a variable inlet air flow demand, the compressor

inlet having adjustable inlet guide vanes, said method comprising

the steps of:

(a) said method further comprises the step of adjusting the relationship between the magnitude of said integral and proportional control signals and the magnitude of said parameter variations as a function of the position of the inlet guide vanes.

HSB 401573

Sundstrand's Articulation of the Rationale for the Amendments is Improper

- Sundstrand claims the “rationale behind the amendment of all of the asserted claims was to add the IGV limitation to overcome the examiner’s prior art rejection and gain allowance of the claims.” (HSC ¶280.)
 - Honeywell added more than just IGV use
 - The prosecution history establishes that IGV was not key to allowance
 - Improperly conflates subject matter of amendment with rationale for amendment

IGV Position Limitation Was Added to Overcome a *Non-Prior Art Objection*

- Examiner states that dependent Claims 17, 35 and 51 will be allowed if rewritten in independent form (HON ¶22.)
- In response Honeywell rewrote these in independent form effectively adding multiple limitations, including IGV position (HON ¶24.)
- Thus, these limitations were added in response to the non-prior art objection to the dependent claims being dependent on rejected independent claims

Sundstrand Ignores CAFC Guidance

- Truism in all *Festo* rebuttal cases that amendment added the term that is subject of equivalents dispute
- Were that enough to defeat the tangential relation test, it would be an impossible standard.

Cordis, 336 F.Supp.2d at 369-70 (Robinson, C.J.)

- CAFC in this case held that IGV was “effectively add[ed]” to the invention, but then remanded.

370 F.3d at 1144.

- If Sundstrand’s explanation of rationale were accurate, no reason for remand.

No Tangential Relation Result is Demonstrated By *Insituform (CAFC 2004)*

- Also involved dependent claim rewritten in independent form
- Prior art had nothing to do with disputed limitation (the number of cups)
- Patentee did not separately explain the addition of the single cup limitation
- Rebuttal established because “no indication in prosecution history of any relationship between the narrowing amendment and a multiple cup process, which is the alleged equivalent in this case.” (385 F. 3d at 1370).